

REMARKS

This is in response to the Office Action mailed on August 25, 2004, and the references cited therewith.

Claims are amended, claims 1, 4, 7, 9-10, 13-15, 18, 21, and 35-36 are amended, claims 3 and 20 are canceled, no claims are added; as a result, claims 1-2, 4-19, and 21-36 are now pending in this application.

§103 Rejection of the Claims

Claims 1-7, 9-24 and 26-36 were rejected under 35 USC § 103(a) as being unpatentable over Cossins (U.S. 6,343,290) in view of Kapoor (U.S. 5,884,038).

Claims 8 and 25 were rejected under 35 USC § 103(a) as being unpatentable over Cossins and Kapoor as applied to claim 1 above, and further in view of Zoken (U.S. 5,994,787).

Applicants do not admit that any one of the above references is prior art, and reserve the right to swear behind these references at a later date. Nevertheless, Applicants respectfully submit that the claims are distinguishable over the above references for the reasons argued below.

The M.P.E.P. states that:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness for at least the following reasons:

- (1) Even if combined, the cited references fail to teach or suggest all of the elements of Applicants' claimed invention;
- (2) The cited references teach away from Applicant's claimed invention; and
- (3) The cited references are nonanalogous art.

1. CLAIMED FEATURES LACKING IN COMBINATION

The reference (or references when combined) must teach or suggest all the claim elements. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 1 of the present application recites:

"receiving a query, including a network address, from an external entity at a geolocation system; and

responsive to receipt of the query, initiating geolocation activities at the geolocation system to map the network address to a geographic location,

wherein the geolocation activities include collecting data pertaining to the network address and mapping the network address to the geographic location based on the collected data."

(Applicants' claim 1, Emphasis Added.)

1.1 COSSINS DOES NOT TEACH GEOLOCATION ACTIVITIES THAT INCLUDE COLLECTING DATA PERTAINING TO THE NETWORK ADDRESS AND MAPPING THE NETWORK ADDRESS TO THE GEOGRAPHIC LOCATION BASED ON THE COLLECTED DATA.

The above-referenced Office Action contends that Cossins "further discloses the geolocation activities (generating a geospatial data based on network data, geographic data and performance elements and mapping to appropriate network elements) include collecting data pertaining to at least the network address..." (Office Action, Page 5, first paragraph).

Applicants respectfully disagree for a number of reasons. Firstly, the Office Action acknowledges that Cossins does not specifically disclose a query including a network address (Page 3). For this reason alone, it stands to reason that Cossins cannot disclose collecting data pertaining to a network address received in a query. The Applicants do, however, note that the Office Action relies on Kapoor for disclosure of a query including an "Internet address". While the Applicants also disagree with this assertion, for reasons more fully set out below, Applicants also fail to see how Cossins could possibly describe the collection of data, pertaining to a network address received in a query, in the absence of a disclosure within Cossins of a query including such a network address.

The Office Action also contends that Cossins "further discloses the geolocation activities (generating a geospatial data based on network data, geographic data and performance elements and mapping to appropriate network elements) include ... mapping the network address to the geographic location based on the collected data..." (Office Action, Page 5, first paragraph).

Applicants again strongly disagree that there is any disclosure in Cossins of mapping a geographic location, associated with a network address received in a query, based on the collected data. Again, as noted in the Office Action, Cossins does not disclose receiving a network address in a query. Accordingly, it follows that Cossins cannot teach the collection of data pertaining to such network address, much less mapping the network address to a geographic location based on such data.

Further, Cossins simply does not deal with mapping a network address to a geographic location. Instead, Cossins describes generating a geocode for received search criteria. This geocode, as far as the Applicants can discern, is a location identifier (e.g., a latitude and a longitude) that is already known and stored as geospatial data. Specifically, Cossins provides some description regarding a geospatial system (306) that communicates with the data management system to obtain stored geospatial data. The geospatial system (306) is described as identifying and generating a geocode (e.g., longitude and latitude) for search criteria and identifying network elements located within a search range of the search criteria, and then generating images and text representing the identified network elements, along with associated performance elements.

In short, Cossins simply fails to provide any discussion regarding the mapping of a network address, received in a query, to a geographic location, the mapping being performed based on collected data pertaining to the network address.

The Applicants have below reproduced portions of Cossins, with appropriate portions emphasized, to assist the Examiner in assessing the limited extent of the disclosure in this reference.

Cossins describes the following:

“The GNMS 104A of FIG. 3 operates as follows. The user 106 transmits a search criteria to the communication system 302 in a communication. The communication system 302 processes the search criteria and transmits the search criteria to the geospatial system 306. The geospatial system 306 geocodes the search criteria, obtains network data and geospatial data from the data management system 304 corresponding to the geocode, and transmits the geocode, the network data, and the geospatial data to the communication system 302. The communication system 302 transmits the geocode, the network data, and the geospatial data to the user 106. The network data and the geospatial data are displayed for the user 106 as a map displaying network elements of a telecommunication network relative to other network elements, geographic elements, and customers. The network elements may have associated performance elements, as described more fully below. The map also displays coverage areas, trouble areas, and layers of network data, including the display characteristics for network elements, performance elements, and geographic elements.

The user 106 navigates through other network data and geospatial data by selecting network elements on the displayed map or by using navigation tools. Additional communications are sent to the communication system 302 identifying the selections. The communication system 302 processes the communications, obtains network data and geospatial data from the geospatial system 306 or the data management system 304 and transmits the network data and the geospatial data to the user 106. In addition, the user can enter network data to configure parameters or components of network elements. This network data is transmitted in a communication to the communication system 302 for implementation and/or storage by the data management system 304. The network data and the geospatial data include, for example, performance data, statistical data, event

data, configuration data, management data, geocode data, geographic data, and other data. In this manner, the user 106 can view, monitor, manage, and configure network data for network elements.

(Cossins, col. 6, ln. 58 – col. 7, ln. 10; Emphasis Added)

Cossins further describes the following:

“The geocode generator 412 identifies and generates a geocode, such as a latitude and a longitude, based on a search criteria. Alternately, the geocode generator 412 can be configured to identify and generate other geocodes, such as a location identifier that designates a geographic location, based on a search criteria. Examples of other location identifiers are latitude and longitude coordinates, north, south, east, west, up, down, left, right, vertical and horizontal coordinates, North American data (NAD) 27, NAD 83, axial coordinates, other ordinate systems, positioning indicators, and mark identifiers.

The map generator 414 identifies network elements and geographic elements located within a search range of a geocode and generates a map having images and/or text representing the identified network elements, including any associated performance elements, and the identified geographic elements. The map may display multiple layers of network data, including trouble tickets, network trouble areas, network alarms, network performance, switch configuration, coverage levels, cell locations, and future cell sites in their proper geographic location. Other layers may exist that may be used to understand the network data and the geographic data.”

(Cossins, col. 8, ln. 58 – col. 9, ln. 14; Emphasis Added)

1.2 KAPOOR DOES NOT TEACH A QUERY, INCLUDING A NETWORK ADDRESS.

The Office Action states that while Cossins does not specifically disclose a query including an Internet address, “Kapoor in the same network management system discloses a query including an Internet address [Client (101 fig. 1) issuing a Domain Name Server (105 fig. 1) resolution request for a IP address to a Domain Name Server, see fig. 1, col.1 lines 26-50 and col. 4 lines 9-54].” (Office Action, page 4, fourth paragraph).

Applicants respectively disagree. Kapoor, with respect to FIG. 1, discloses that a client makes a DNS resolution request to a DNS server. A DNS resolution request in fact does not include an IP address, but instead includes a host name (e.g., www.2.Internet_Host_ABC.com), and is a request for an IP address for the relevant host name. Accordingly, the DNS resolution request referenced in the Office Action is in fact a request for an Internet address, as opposed to being a query including a network address, as required by claim 1.

Applicants have again reproduced the relevant portion of Kapoor below, emphasizing text in support of the Applicants’ arguments presented immediately above.

Kapoor describes the following:

“ FIG. 1 is a block diagram that illustrates a client 101 trying to connect to a web server 103 of an Internet Host ABC. As shown in FIG. 1, client 101 makes a DNS resolution request 107 to DNS server 105 to request the IP address of web server 103. DNS server 105 returns the IP address response 109 in reply to the DNS resolution request 107.”

(Kapoor, Col 1, lines 26-32, Emphasis Added).

2. THE CITED REFERENCES TEACH AWAY FROM APPLICANTS' CLAIMED INVENTION.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

Applicants contend that Kapoor in fact teaches away from the claimed combination for at least the following reason. As noted above, Kapoor is concerned with DNS resolution requests, which are in fact requests to retrieve an IP address. This is in direct contrast to the claimed invention, which is concerned with a query that includes a network address.

3. OTHER CLAIMS

While the above arguments have been presented specifically with respect to claim 1 of the present application, the other independent claims of the present application each include similar limitations. Accordingly, the Examiner is respectfully requested to consider the above remarks with respect to these further independent claims.

The dependent claims of the present application include, either directly or indirectly, the limitations of the independent claims argued above to be patentable over the three cited references. These dependent claims are accordingly also considered patentable in view of the additional elements (or limitations) which they provide to a patentable combination. If any independent claim is non-obvious under 35 U.S.C. Section §103, then any claim depending there

from is also non-obvious. M.P.E.P. Section §2143.03.

Title: METHOD AND SYSTEM TO INITIATE GEOLOCATION ACTIVITIES ON DEMAND AND RESPONSIVE TO RECEIPT OF A QUERY

Conclusion

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-333-9972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

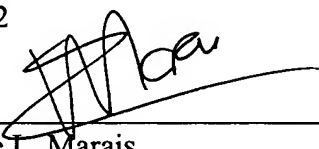
Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of January, 2005.

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